

REMARKS

This Amendment, filed in reply to the Office Action dated November 17, 2005, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

Applicant gratefully acknowledges the courtesies extended by the Examiner in the Interview of March 9, 2006. Applicant hereby requests withdrawal of the pending rejection of at least claim 16 since it appears that the Examiner agreed that the cited art did not teach all the features of this claim.

Claims 1, 3-6, 8-17, 19-22, 24-33 and 39-42 remain pending the application. Claims 1, 3, 4, 6, 8-11, 17, 19-20, 22, 24-27, 36-37 and 39-42 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Stevenson et al. (U.S.P. 6,393,161) and Sugiura et al. (U.S.P. 6,034,766). Claims 5 and 21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Stevenson and Sugiura and further in view of Suganuma (U.S.P. 6,034,794). Claims 12 and 28 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Stevenson and further in view of Denber (U.S.P. 5,214,470). Claims 13-14 and 29-30 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Stevenson and Sugiura and further in view of LeCouteur (GB 1547811). Claims 15-16 and 31-32 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Stevenson and LeCouteur and further in view of Sugiura. Claim 33 has been rejected under 35 U.S.C. §

103(a) as being unpatentable over the combination of Denber, LeCouteur and Sugiura.

Applicant respectfully submits the following arguments in traversal of the prior art rejections.

As a preliminary matter, the Examiner objects to the specification under 35 U.S.C. 112, first paragraph as allegedly failing to provide a full, clear and concise description of the invention. However, the Examiner has not identified any particular objectionable language. Accordingly, Applicant submits that the specification complies with all requirements of Section 112. As a further preliminary matter, claims 41-42 are amended to correct informalities. Applicant submits that the amendments should be entered because they raise no new issues requiring further consideration.

With regard to the rejection under 35 U.S.C. § 103, the Examiner does not offer any particular technical rebuttal to previously cited arguments regarding the impropriety of the primary combination of Stevenson and Sugiura. The Examiner relies on general contentions that the claimed feature need not be expressly taught and also notes that the features of the references need not be bodily incorporated to maintain the rejection. Both of these general rebuttals fail to address the specific argument that the teachings of the Stevenson and Sugiura references would render each inoperable for their intended purpose.

As previously submitted, in Stevenson, the detection of a spot existing on a parallel plate 12, for example, relies on **detection of light at a spot S at a reduced intensity**. By contrast, in Sugiura, the concept of the defect detection relies on the **absence of receipt of any focused light** information in the event there is no defect in the optical element disposed in the light path

between the light source and line sensor. If the features of Sugiura were combined with Stevenson, the lack of light detection for the defect-free optical element would not provide any light detection to ascertain the defects as they occur due to spot S in Stevenson. In similar regard, the detection of a light in Sugiura corresponds to the detection of an error in an optical element. If such light were detected in the detecting apparatus of Stevenson, the spot S again could not be accurately detected due to the detection of the extraneous light. Thus, the combination defeats the purpose of each reference. The references would each need to undergo redesign in a manner that is not contemplated by either reference. Applicant submits that it is well-settled that references requiring a redesign to meet claim recitations cannot support obviousness rejections since the teachings of the claims are not taught or suggested. *In re Ratti*, 123 USPQ 349 (Fed. Cir. 1959).

Additionally, modifications that render the references inoperable for their intended purpose cannot support a prior art rejection. Moreover, rather than providing multiple sources of defect detection as the Examiner contends, the cited combination would result in the inability to detect an error at a spot S. Therefore the motivation for combining Stevenson and Sugiura is not supportable for this additional reason. The Examiner has not indicated any error in these statements of the operation of each reference. Thus, for each reference to operate in combination with the other, there would effectively be a redesign of each reference. This exemplifies improper hindsight reconstruction. Therefore, claim 1 is patentable.

Because claim 17 includes recitations analogous though not necessarily coextensive with claim 1, claim 17 is also patentable for the reasons set forth above for claim 1. Their dependent

claims are patentable for similar reasons. The additional references of Suganuma, Denber and LeCouteur do not make up for the deficiencies of the primary combination.

With further regard to claim 40, this claim describes a change in focus between the optical element and the recording medium. The Examiner relies on Col. 9 of Sugiura to teach this feature. However, the cited column merely describes adjustment of a line sensor focus. There is no requirement that the focus be changed between the elements as claimed, and such is not necessary because Sugiura does not contemplate multiple forms of error detection of the medium and optical element. Claim 39 is patentable for analogous reasons.

With further regard to claims 41-42, these claims describe that the optical element on which the focusing position is set is an element disposed on a midway of the optical path to a reading position of the detecting light. The Examiner relies on Fig. 1 of Sugiura to teach this feature. However, in Sugiura, the focusing position of lens 4 is at the medium and not at an optical element. Therefore, claims 41-42 are patentable for these additional reasons.

With regard to claim 33, the Examiner maintains that the combination of Denber, LeCouteur and Sugiura teaches all features of this claim. It was previously submitted that none of the references teach both the detection of the medium and the optical element using invisible light. The Examiner's rebuttal contends that in Denber, the detection of a defect on a platen results in defect detection of the optical element and medium. Applicant maintains that the detection relates only to platen defect detection. When a document is placed on the platen, the opaque medium would cover the platen. Therefore, contrary to the Examiner's contention,

reading of the defect in the platen does not indicate any defect in the medium. The Examiner's further reliance on LeCouteur does not negate the fact that no reference detects the defects of both the medium and the optical element as claimed. Therefore, claim 33 is patentable.

Applicant submits that claims 15 and 33 also describe change of focusing positions between light sources such that the focusing positions are different from each other. Because the focus surfaces for defect light and read light do not change in the cited art, claims 15 and 33 are patentable for this additional reason.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.116
Appln. No.: 09/657,272

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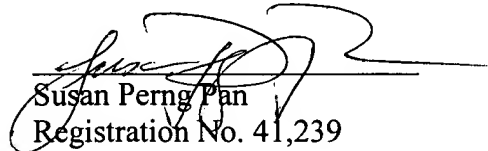
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